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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,846	12/27/2000	Mina L. McKay	YOR920000563US1/I27-0002	4804

7590 09/15/2005
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EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT PAPER NUMBER

3623

DATE MAILED: 09/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/749,846

Applicant(s)

MCKAY ET AL.

Examiner

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-30, 33-37, 39-43, 46-70, 73-75 and 77-82 is/are pending in the application.
- 4a) Of the above claim(s) 2, 3, 16-24, 26-30, 33-35, 42, 43, 56-64, 66-70 and 73-75 is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6-15, 25, 36, 37, 39-41, 46-55, 65 and 77-82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 5, 2005 has been entered.

Claims 1, 6-10, 12, 15, 25, 36, 37, 41, 46-50, 52, 55, 77-82 have been amended.

Claims 5, 45, and 76 have been cancelled.

Claims 2, 3, 16-24, 26-30, 33-35, 42, 43, 56-64, 66-70, and 73-75 stand as withdrawn.

Claims 1, 6-15, 25, 36, 37, 39-41, 46-55, 65, and 77-82 are presented for examination.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 6-15, 25, 36, 37, 39-41, 46-55, 65, and 77-82 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 6-15, 25, 36, 37, 39-41, 46-55, 65, and 77-82 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said activity *selected*" in line 8. There is insufficient antecedent basis for this limitation in the claim because it is not clear if the request to initiate an activity indicates that the activity was selected (i.e., it is not clear if "said activity selected" is equivalent to the requested activity).

Claim 1 recites the limitation "said activity options" in the last line. There is insufficient antecedent basis for this limitation in the claim.

Claim 25 recites the limitation "said activity *selected*" in lines 12-13. There is insufficient antecedent basis for this limitation in the claim because it is not clear if the request to initiate an activity indicates that the activity was selected (i.e., it is not clear if "said activity selected" is equivalent to the requested activity).

Claim 25 recites the limitation "said activity options" in the last line. There is insufficient antecedent basis for this limitation in the claim.

Claim 36 recites the limitation "said activity *selected*" in line 17-18. There is insufficient antecedent basis for this limitation in the claim because it is not clear if the request to initiate an activity indicates that the activity was selected (i.e., it is not clear if "said activity selected" is equivalent to the requested activity).

Claim 41 recites the limitation "said activity *selected*" in line 10. There is insufficient antecedent basis for this limitation in the claim because it is not clear if the

request to initiate an activity indicates that the activity was selected (i.e., it is not clear if "said activity selected" is equivalent to the requested activity).

Claim 41 recites the limitation "said activity options" in the last line. There is insufficient antecedent basis for this limitation in the claim.

Claim 65 recites the limitation "said activity *selected*" in lines 13-14. There is insufficient antecedent basis for this limitation in the claim because it is not clear if the request to initiate an activity indicates that the activity was selected (i.e., it is not clear if "said activity selected" is equivalent to the requested activity).

Claim 65 recites the limitation "said activity options" in the last line. There is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 6-15, 25, 36, 37, 39-41, 46-55, 65, and 77-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over McFarland (U.S. Patent No. 6,154,753) in view of Bons et al. ("A Formal Specification of Automated Auditing of Trustworthy Trade Procedures for Open Electronic Commerce").

McFarland discloses a method for facilitating supplier auditing functions in a

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communications network environment, comprising:

[Claim 1] receiving a request from a user system of an enterprise system to initiate an activity, said activity including scheduling an audit for performing an initial or ongoing qualification of a supplier enterprise (Figs. 1, 62, 65; col. 24, lines 20-30; col. 25, lines 33-34; col. 26, lines 5-15; col. 28, lines 28-30);

said enterprise system retrieving data from at least one database, said data corresponding to said activity selected (Figs. 1, 7, 61-72; col. 23, line 65 through col. 28, line 46); and

transmitting said data to said user system (Figs. 1, 7, 61-72; col. 23, line 65 through col. 28, line 46);

wherein said scheduling said audit includes:

entering supplier data into a schedule form (Figs. 62-66; col. 24, lines 25-30; col. 26, lines 16-30);

entering requester information into said schedule form (Figs. 62-66; col. 24, lines 25-30; col. 26, lines 16-30);

selecting an auditor to perform said audit (Figs. 62-67; col. 24, lines 25-30; col. 25, lines 4-34; col. 26, lines 16-30);

entering a purpose for said audit (Figs. 62-66; col. 24, lines 25-30);

entering a time frame for performing said audit (col. 24, lines 25-30 -- An audit date is input); and

distributing a completed schedule form to at least one entity (Figs. 62-66; col. 24, lines 20-30; col. 25, lines 33-34; col. 26, lines 5-15; col. 28, lines 28-30); and

wherein further said enterprise system includes a quality information network application for executing activity options (Figs. 1, 7, 61-72; col. 23, line 65 through col. 28, line 46);

[Claim 6] wherein said distributing said completed schedule form is automatically performed by said quality information network application via a distribution list (col. 25, lines 4-34; col. 26, lines 5-15 -- Since only eligible auditors may be assigned to complete an audit, it is understood that they are part of an approved distribution list for certain audits, based on input from a requester. The distribution can be said to be performed automatically in the sense that all communications are conducted electronically while the distribution can also be viewed as performed manually in the sense that the requester selects an auditor from the list of eligible auditors);

[Claim 7] wherein said distributing said completed schedule form is manually performed by said requester via a distribution list provided by said requester (col. 25, lines 4-34; col. 26, lines 5-15 -- Since only eligible auditors may be assigned to complete an audit, it is understood that they are part of an approved distribution list for certain audits, based on input from a requester. The distribution can be said to be performed automatically in the sense that all communications are conducted electronically while the distribution can also be viewed as performed manually in the sense that the requester selects an auditor from the list of eligible auditors);

[Claim 9] wherein said selecting said auditor by said requester includes selection criteria including:

geographic location of site to be audited (col. 25, lines 4-34);

auditing skills possessed by said auditor (col. 25, lines 4-34);
a commodity subject to said audit (col. 25, lines 4-34); and
auditor pre-qualification data (col. 25, lines 4-34);

[Claim 13] wherein said activity includes viewing a scheduled audit (col. 28, lines 28-37).

Regarding claim 1, McFarland does not expressly teach that the audit is being requested for an initial or ongoing qualification of an existing or prospective trading partner of the enterprise. However, Bons discusses the importance of establishing trust between trading parties (abstract), especially between new trade partners. Section 1 of Bons (pages 1-2) explains that “[m]odern businesses are confronted with an increasing need to deliver customer-specific products and services at a competitive level of costs. This poses high requirements on the company’s ability to organise its contracts with both suppliers and customers in a flexible, efficient, and effective way.” Electronic tools provide businesses with trading partners throughout the globe. Bons describes a way to facilitate a speedy establishment of mutual trust through use of electronic agents to automatically check the trustworthiness of new trading partners (abstract). McFarland too is directed toward facilitating quick and efficient auditing of a business; therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant’s invention to adapt McFarland to perform audits that are being requested for an initial or ongoing qualification of an existing or prospective trading partner of the enterprise in order to place McFarland’s business users in a more

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advantageous global position when it comes to establishing trusted relationships among various trading partners (e.g., wherein the supplier data is related to the trading partner), thereby allowing these businesses to more successfully compete in a global environment.

[Claim 8] As per claim 8, McFarland teaches that said requester is a divisional user (col. 26, lines 23-25), yet neither McFarland nor Bons expressly teaches that the divisional user comprises at least one of an engineer and developer of the enterprise system, the divisional user requesting an audit of a trading partner that corresponds with an engineering or developer group to which the divisional user belongs. However, Official Notice is taken that it is old and well-known in the art to audit a corresponding engineering or developer group of a trading partner. This helps a company decide, on a departmental level, which trading partners are best suited to the company's specific departmental level needs. McFarland performs audits at a departmental level; therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to adapt the McFarland-Bons combination to allow for participation of a divisional user comprising at least one of an engineer and developer of the enterprise system, the divisional user requesting an audit of a trading partner that corresponds with an engineering or developer group to which the divisional user belongs in order to help a company decide, on a departmental level, which trading partners are best suited to the company's specific departmental level needs.

[Claims 10, 11] McFarland must notify an auditor to complete a scheduled audit in

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order to achieve actual completion of an audit (col. 26, lines 5-15). Since McFarland's communications are performed electronically, such a notification can be said to be automatic (as per claim 10). However, McFarland does not expressly teach that the auditor can confirm or reject the notice to perform an audit. Official Notice is taken that it is old and well-known in the art of project management to allow a user to accept or reject a task. Furthermore, Official Notice is taken that it is old and well-known in the art of project management to select a back-up person to perform a task when a first person cannot perform it. This allows for efficient task allocation and timely task completion when a first person is not available to complete an assigned task (e.g., due to vacation, illness, etc.). Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify McFarland to perform the steps of receiving a response to the notice from said auditor by said requester, wherein said response is either a confirmation notice or a rejection notice (as per claim 10), wherein said requester initiates a second auditor selection, based upon receiving said rejection notice (as per claim 11) in order to facilitate efficient task allocation and timely task completion when a first person is not available to complete an assigned task (e.g., due to vacation, illness, etc.).

[Claim 12] While McFarland teaches that a date planned for an audit may be entered (col. 24, lines 24-26; col. 26, lines 5-15), neither McFarland nor Bons expressly teaches that a quarter planned for said audit may be entered. However, Official Notice is taken that it is old and well-known in the art to schedule audits at a given frequency in order to promote consistent monitoring of the quality of an organization. Therefore, the

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Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the McFarland-Bons combination to allow a user to enter a quarter planned for said audit in order to promote consistent monitoring of the quality of an organization of a quarterly basis.

[Claims 14, 15] While McFarland teach that one may view said scheduled audit by categories, said categories including completed audits (col. 28, lines 28-37) and planned audits (col. 28, lines 28-37), neither McFarland nor Bons expressly provides a view for all audits (claim 14) or by trading partner, region, quarter by region by commodity, year by quarter, product category, requester, auditor, organization, or site owner (claim 15). However, Official Notice is taken that it is old and well-known in the art to filter information for display based on user-specified filter conditions. The filter conditions recited in claims 14 and 15 are merely analogous to well-known filtering conventions utilized to enable a user to more quickly and easily assess a limited subset of data of interest to him/her. Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the McFarland-Bons combination to allow a user to specify various viewing conventions for audits, including a view for all audits (claim 14) or by trading partner, region, quarter by region by commodity, year by quarter, product category, requester, auditor, organization, or site owner (claim 15) in order to provide the user with a convenient manner of more quickly and easily assessing a limited subset of data of interest to him/her.

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[Claims 41, 46-55] Claims 41 and 46-55 recite limitations already addressed by the rejection of claims 1 and 6-15 above; therefore, the same rejection applies.

McFarland discloses a method for facilitating supplier auditing functions in a communications network environment, comprising:

[Claim 25] receiving a request from a first enterprise system to contact a second enterprise system, the first enterprise system including a supplier of the second enterprise system (Figs. 1, 62, 65; col. 24, lines 20-30; col. 25, lines 33-34; col. 26, lines 5-15; col. 28, lines 28-30);

receiving a request to initiate an activity, said activity including viewing results of an audit performed by the second enterprise system (Figs. 1, 7, 61-72; col. 23, line 65 through col. 28, line 46);

said second enterprise system retrieving data from at least one database, said data corresponding to said activity selected (Figs. 1, 7, 61-72; col. 23, line 65 through col. 28, line 46); and

transmitting said data to said first enterprise system (Figs. 1, 7, 61-72; col. 23, line 65 through col. 28, line 46);

wherein said second enterprise system includes a quality information network application for executing activity options (Figs. 1, 7, 61-72; col. 23, line 65 through col. 28, line 46).

As per claim 25, neither McFarland nor Bons expressly teaches that their system

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is integrated via a web site maintained by an enterprise system that authenticates a user's ID and password via a firewall or that her communications network environment includes an extranet. However, McFarland does allow for audits to be performed by external third party auditors (Fig. 7; col. 24, lines 20-29). Furthermore, Official Notice is taken that it is old and well-known in the art of inter-enterprise communications to utilize a web site (such as an Internet-based web site) maintained by an enterprise system that authenticates a user's ID and password via a firewall and a communications network environment that includes an extranet in order to promote secure communications among users from different organizations. Since McFarland allows for audits to be performed by external third party auditors, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify the McFarland-Bons combination to incorporate a web site (such as an Internet-based web site) maintained by an enterprise system that authenticates a user's ID and password via a firewall and a communications network environment that includes an extranet in order to promote secure communications among users from different organizations (including external third party auditors), especially where confidential documents are concerned.

[Claims 36, 37, 39, 40, 77-82] Claims 36, 37, 39, 40, and 77-82 recite limitations already addressed by the rejection of claims 6-10 and 25 above; therefore, the same rejection applies.

Furthermore, it should be noted that the McFarland-Bons combination addressed

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in the rejection of claim 25 above would necessarily incorporate a host system including a workstation, a web server, an applications server, and a database server, a data storage device in communication with said host system, quality information network software application being executed by said host system, a firewall in communication with said host system, a workstation, and a computer network connecting the host system to the workstation, wherein information inputted into the workstation is transferred to the host system and made available to the quality information network software application (as per claim 36). The rejection of claim 25 addresses the obviousness of incorporating with the McFarland-Bons combination an enterprise system that authenticates a user's ID and password via a firewall and a communications network environment that includes an extranet. An extranet implies that inter-enterprise communications are facilitated.

McFarland discloses:

[Claim 37] wherein said data storage device includes:

a reference database (Figs. 1, 7, 61-72; col. 23, line 65 through col. 28, line 46);

an audit schedule database (Figs. 1, 7, 61-72; col. 23, line 65 through col. 28, line 46);

an audit reports database (Figs. 1, 7, 61-72; col. 23, line 65 through col. 28, line 46);

an executive summary database (Figs. 1, 7, 61-72; col. 23, line 65 through col. 28, line 46); and

a supplier quality performance database (Figs. 1, 7, 61-72; col. 23, line 65 through col. 28, line 46).

McFarland does not expressly teach that the supplier quality performance database relates to the trading partner; however, the implication that the stored data is trading partner data amounts to nothing more than non-functional descriptive material. Therefore, the differences between this limitation and McFarland are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106. Nevertheless, as discussed in the rejection of claim 1 above, the McFarland-Bons combination addresses the auditing of trading partners; therefore, the Examiner submits that the McFarland-Bons combination would necessarily incorporate a supplier quality performance database relating to the trading partner in order to facilitate the automated audit of the trading partner.

[Claim 65] Claim 65 recites limitations already addressed by the rejection of claim 25 above; therefore, the same rejection applies.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Susanna M. Diaz
Primary Examiner
Art Unit 3623

September 3, 2005